



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/267,025	03/11/99	SHIELDS R	TF-2018-03 R

THOMAS C FEIX
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SAN MATEO CA 94401

IM71/0724

EXAMINER
WATKINS III, W

ART UNIT	PAPER NUMBER
1772	14

DATE MAILED: 07/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/267,025

Applicant(s)

Shields

Examiner

William P. Watkins III

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 9, 11, 12 and 22-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 9, 11-12, and 22-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

1. Pursuant to the August 28, 2000 Notice Regarding Power of Attorney, Paper No. 13, the revocation and power of attorney filed March 27, 2000 as paper no. 12 has NOT been accepted. Correspondence from this office will continue to be sent to the previous address:

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2. Since reissue applications are open to the public, however, a courtesy copy of this Office Action will be sent by fax to Mr. Michael A. Kaufman at 415-398-3249.

3. The March 27, 2000 Amendment is acknowledged and entered as a paper filed by a registered attorney. See MPEP 405 (7th ed., rev. 1, Feb. 2000). The pending claims are 1-5, 7, 9, 11, 12, and 22-70. All other claims have been canceled.

Objection under 37 CFR 1.172(a)

4. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must

establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

The "Assignment of Patent Application" filed June 28, 1999 in application no. 08/081,728 is duly noted. However, no such assignment is found in application no. 08/324,889, now US 5,609,938, the subject of the instant reissue. Since 08/324,889 was a continuation in part of 08/081,728, the assignment in 08/081,728 does not carry over to 08/324,889. See MPEP 306.

Rejection under 35 USC 102(f)

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(f) he did not himself invent the subject matter sought to be patented.

6. Claims 1-5, 7, 9, 11-12, 22-70 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

At p. 5, para. 8, of the "Statement of facts in support of filing on behalf of nonsigning inventor", filed June 28, 1999 in the present reissue application, Mr. Felix, the attorney of record, sets forth his discussion with the inventor, Mr.

Shields:

On June 23, 1999, 3:45 pm, I telephoned Mr. Shields. Mr. Shields told me that he heard from one of his "sources" that some third party (unknown to him) was making some claim of prior inventorship in certain features of the '938 patent. Mr. Shields also asserted that Greg Ross had been made aware of this situation. Mr. Shields also informed me that he would not sign the declaration papers until he was provided with full disclosure of information concerning the unknown third party's claim of prior inventorship in certain features of the '938 patent. I informed Mr. Shields that I was unaware of any such claim.

The inventor apparently refused to sign the oath or declaration in this case because of assertions of prior inventorship made by a third party. Under 37 CFR 1.63(b)(2) and (3), the oath or

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declaration signed by the inventor must state that he is the "original and first inventor or inventors of the subject matter which is claimed" and that he " acknowledges the duty to disclose to the Office all information known to the person to be material to patentability".

In her affidavit accompanying the "Petition for the Institution of Public Use Proceedings" filed by a third party on December 8, 1999, Ms. Linda M. Icard sets forth facts which essentially show that she should have been listed as at least a co-inventor. The affidavit shows that she was involved in the conception (pp. 6 and 7) and reduction to practice (pp. 7-15) of at least part of the invention claimed in the present reissue. In particular, the "Old Joe" product is discussed at pp. 13-15 of the affidavit, in which Ms. Icard indicated that she and her husband had developed "a one-way vision display panel assembly" comprising the presently claimed components of a) a perforated panel assembly including a perforated panel, perforated protective line, and adhering means; b) a first coating and a second coating; and c) a non perforated backing layer.

The record in this reissue shows that the inventor has refused to sign an oath or declaration stating that he was the "original and first inventor" and that someone else has submitted

an affidavit setting forth facts which show that the other person was at least a co-inventor. In view of the record as a whole, therefore, sufficient evidence is found to support a prima facie determination that the inventor "did not himself invent the subject matter sought to be patented" under 35 USC 102(f). See MPEP 2137 et seq.

To overcome this rejection, declaratory evidence should be presented, supported by sufficient documentation, to show that the inventor was the "original and first inventor ... of the subject matter which is claimed". Claims for which the showing cannot be made should be canceled. Alternatively, the inventorship may be corrected. See MPEP 201.03, 1412.04, 2137.01. Another possibility is the showing that the claimed subject matter was commonly owned at the time the invention was made. See MPEP 2137.02.

Other issues

7. All other issues, including rejections and the Petition for Institution of Public Use Proceedings, are held in abeyance, until resolution of the above issues.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William

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P. Watkins III whose telephone number is 703-308-2420. The examiner can normally be reached on M-F 9:30 A.M.-6:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.


WILLIAM P. WATKINS III
PRIMARY EXAMINER

WW/ww

July 15, 2001

Conferee:



Douglas McGinty

Special Program Examiner



UNITED STATES PATENT AND TRADEMARK OFFICE

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Sent 7-25-01
W. Williams

Fax Cover Sheet

Date: 25 Jul 2001

To: <i>Michael A. Kaufman</i>	From: <i>W. Williams</i>
Application/Control Number: <i>09/267,025</i>	Art Unit: <i>1772</i>
Fax No: <i>415-398-3249</i>	Phone No: <i>703-308-2420</i>
Voice No.: <i>415-781-1981</i>	Return Fax No:
Re: <i>Copy of OK Vice Action</i>	CC:
<input type="checkbox"/> Urgent <input type="checkbox"/> For Review <input type="checkbox"/> For Comment <input type="checkbox"/> For Reply <input type="checkbox"/> Per Your Request	

Comments:

See paragraph # 2

Number of pages *9* including this page

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Assistant Commissioner for Patents